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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,976	02/25/2004	Olof Ramstrom	003300-653	8984
21839 7590 05/04/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER GROSS, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER
			1639	
			MAIL DATE	DELIVERY MODE
			05/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/784,976	Applicant(s) RAMSTROM ET AL.	
	Examiner Christopher M. Gross	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/1/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Responsive to communications entered 2/1/2007. Claims 1-10 are pending. Claims 6,9,10 are withdrawn. Claims 1-5,7,8 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Applicant's election with traverse of the species of "steroids" in the reply filed on 6/8/2006 is again acknowledged; Claims 6,9,10 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Priority

This application is a CON of 10/263,195 10/03/2002 (now ABN) which is a CON of 09/607,925 06/30/2000 (now ABN) which is a CON of PCT/SE98/02413 12/22/1998.

Maintained Claim Rejection(s) - 35 USC § 102

Claims 1-5,7,8 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitcombe et al (1995 JACS 117:7105-7111).

Claims 1-5,7,8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bystrom et al (1993 JACS 115:2081-2083).

Claims 1-5,7 and 8 rejected under 35 U.S.C. 102(e) as being anticipated by Mosbach et al (US Patent 6255461).

Response to Arguments

Applicant argues not all elements are taught.

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Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

Specifically, applicant argues see p4-6 (2/1/2007) none of Whitcombe et al, Bystrom et al or Mosbach et al teach a combinatorial library according to the definition set forward by Richard Twyman on the Human Genome Website at the Wellcome Trust Sanger Institute: "Combinatorial libraries are large collections of chemical compounds"

However, the office is not bound to a single hand-picked definition from the prior art, but rather to the broadest reasonable interpretation in view of the specification and prior art combined. Further, it is noted, a definition as to what constitutes a combinatorial library is not found the present specification.

Solely to rebut applicant's argument, the claimed subject matter is drawn to a "combinatorial library" of compounds; however, the term is used quite broadly in the art to mean "any ensemble of molecules" (e.g., see Janda, K. D. "Tagged versus untagged libraries: Methods for the generation and screening of combinatorial chemical libraries" PNAS USA November 1994, 91, 10779-10785, especially page 10779, column 1, last sentence, "In its purest form, a combinatorial chemical library can be defined as any ensemble of molecules"). As there is no specific definition of a library in Applicants' specification, any ensemble of molecules that reads on those set forth in the claims is deemed to be a library.

Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., large collections of chemical compounds) are not recited in the

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rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

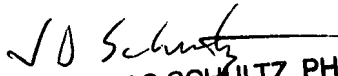
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

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J. DOUGLAS SCHULTZ, PH.D.
SUPERVISORY PATENT EXAMINER